

## REMARKS/ARGUMENTS

In response to the Office Action dated September 28, 2004, Applicants respectfully request the Office to enter the above amendments and consider the following remarks. By this amendment, Applicant amends claims 5, 14, 24, 25, 35, 38 and 39, and cancels claim 33 without prejudice or disclaimer. No claims have been added by this amendment. After entry of this paper, claims 5-9, 14-17, and 24-32, 34-40 remain pending in this application.

In the Office Action, the Examiner: (i) objected to the specification with respect to several claim terms interpreted by the Office; (ii) objected to claims 38 and 39 with respect to language informalities; (iii) rejected claims 25-31, 35, 37, 38 and 40 under 35 U.S.C. § 102(b) as allegedly being unpatentable over U.S. Patent No. 5,594,897 to Goffman ("Goffman"); (iv) rejected claims 5-9, 14-17 and 24 under 35 U.S.C. § 102(e) as allegedly being unpatentable over U.S. Patent No. 6,289,342 to Lawrence et al. ("Lawrence"); and (v) rejected claims 32-34, 36 and 39 under 35 U.S.C. § 103(a) as being unpatentable over Goffman in view of U.S. Patent No. 5,835,905 to Pirolli et al. ("Pirolli").

### Objections to the Specification

The specification was objected to with respect to several claims term interpreted by the Office. Claims 5, 14 and 24 were objected to based on the use of "virtual board." Claim 25 was object to based on the use of "extended document." Claim 33 was objected to based on the use of "user-provided relational information."

Applicants submit that the Office's interpretations are mistaken in their over-breadth, and provide the correct interpretations of these terms, below. "Virtual board" should be interpreted as graphical depiction of a board on a graphical user interface, such as, e.g., the "content board" (Specification, Page 28, Lines 21-22), the "citation board" (Specification, Page 29, Line 7), etc., rather than just a

graphical user interface. "Extended document" should be interpreted as the "medium" or "publication" discussed throughout the specification (see, e.g., the discussion of the 'electronic publication' on page 33, lines 13-20 of the Specification), rather than "simply a collection of objects displayed on a graphical user interface." Claim 33 has been canceled without prejudice or disclaimer, and thus Applicants submit that the objection to "user provided relational information" is moot. Applicant express their appreciation for the telephonic interview granted with the undersigned and inventor Stuart Card, wherein the objected-to language was discussed as well as aspects of the invention that might better define over Goffman.<sup>1</sup>

Therefore, Applicants submit that the instant objections have been overcome, and should be withdrawn. If the Examiner believes that the objections have not been overcome, he is encourage to contact the undersign via telephone at (650) 849-6643 for further clarification.

#### Claim Objections

Claims 38 and 39 were objected to based on informalities pointed out by the Office. Appropriate correction has been made, and Applicants submit that the instant objections have thereby been overcome.

#### Claim Rejection Under 35 U.S.C. § 102(b)

Claims 25-31, 35, 37, 38 and 40 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Goffman.

While respectfully disagreeing with the Office position, Applicants submit that independent claims 25 and 35, as amended, are patentable over Goffman. Claims 25 and 35 have been amended to more clearly distinguish the database creation and document retrieval of Goffman. Specifically, claim 25 has been

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<sup>1</sup> This represents Applicants' complete written statement, in accord with 37 C.F.R. § 1.133(b), if such is necessary.

amended to recite that the relational information is "previously generated and pre-stored", and that it is adapted to be graphically depicted and "rearranged as a function of the pre-stored relational information and user input on a graphically-depicted virtual board displayed on a user interface." Similarly, claim 35 has been amended to recite "generating the storage medium in a format capable of variable electronic dissemination as a function of the analysis," as well as that the storage medium includes "previously generated and pre-stored relational information" and that "the relational information is adapted to be graphically depicted and rearranged as a function of the pre-stored relational information and user input on a user interface."

Goffman, on the other hand, cannot be found to teach or suggest the claimed invention, as amended herein. Goffman is directed to the straightforward collection of, e.g., journals, into a database, using an algorithm designed to select a core (e.g., most important) set of objects from a larger overall source collection. The only analysis performed by Goffman is a simple perusal of the data tree structure between items in the source collection to determine one's dominance over another; the core items are then selected according to dominance. The database created, then, provides a hit list of these "core" objects. Thus, Goffman neither teaches nor suggests the storage medium implementation set forth in independent claims 25 and 35, and certainly does not disclose, inter alia, the "pre-stored relational information" or the graphical depiction and "rearrangement" of information, as has now been set forth in the currently amended versions of these claims to more clearly claim the invention.

For at least the foregoing reasons, Goffman does not anticipate claims 25 and 35, as amended. Accordingly, Applicants request that the rejection of claims 25 and 35 under 35 U.S.C. 102(b) be withdrawn and the claim allowed.'

Claims 26-31 depend upon claim 25 and therefore include all elements and recitations thereof. Similarly, claims 37, 38 and 40 depend upon claim 35 and therefore include all its elements and recitations. As explained above, claims 25 and 35 are

patentable over Goffman. Accordingly, claims 26-31, 37, 38 and 40 are also patentable under 35 U.S.C. 102(b) for at least the same reasons given above.

Claim Rejection Under 35 U.S.C. § 102(e)

Claims 5-9, 14-17, and 24 stand rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Lawrence.

While again respectfully disagreeing with the Office's position, the independent claims under rejection here, claims 5, 14 and 24, have been amended to set forth further graphical recitations regarding the display of information on the graphical user interface. Specifically, for example, claim 5 has been amended to recite "wherein said display of information is graphically implemented via change in graphical indicia" as well as that the display information is "capable of graphical rearrangement as a function of the relational information," claim 14 has been amended similarly to recite a controller that instructs the display of information regarding the source material and set of secondary materials to be updated via "change in graphical indicia on a graphically-displayed virtual board" with similar capability for "graphical rearrangement as a function of the relational information," and claim 24 has been amended in a corresponding manner.

Applicants respectfully submit that Lawrence does not disclose or suggest, *inter alia*, the graphical limitations now recited in these claims, as set forth above. As seen in the specification (columns 1-22; columns 5-22, in particular) and the figures (Figs. 1-10 are merely textual hit lists), Lawrence only operates to provide the source document and/or a list of documents (and limited textual information concerning the document) derived by means of predefined (e.g., keyword) search mechanisms.

Therefore, because Lawrence fails to teach the virtual board and related graphical limitations now set forth in independent claims 5, 14 and 24, it is respectfully submitted that these claims are now in condition for allowance. Claims 6-9 and 15-17 are dependent upon claims 5 and 14, respectively, are thus also allowable for at least the same reasons set forth above.

Claim Rejection Under 35 U.S.C. § 103(a)

Claims 32-34, 36 and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Goffman in view of Pirolli. Claim 33 has been canceled without prejudice or disclaimer (see above).

Applicants respectfully submit that Pirolli does not cure the deficiencies set forth above regarding Goffman with respect to claims 25 and 35, from which claims 32, 34, 36 and 39 depend. Therefore, for at least the reasons set forth above, Applicants submit that neither Goffman, nor the combination of Goffman and Pirolli, teaches or suggests the claimed invention as set forth in claims 32, 34, 36 and 39. Accordingly, Applicants request that the instant rejection with respect to these claims be withdrawn.

Lastly, Applicants note that the amendments to the claims, herein, shall not subject the subject matter prior to amendment to prejudice, disclaimer or surrender.

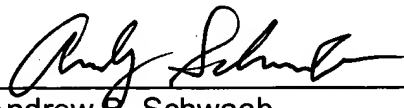
In view of the foregoing amendments and remarks, Applicant submits that the pending claims are in allowable form, and respectfully requests reconsideration of the objections/rejections and the timely allowance of the claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Xerox's deposit account 24-0037.

Respectfully submitted,

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